

REMARKS

Claims 1 – 20 stand rejected. The independent claims are claims 1, 10, 15 and 17.

Rejections Under 35 USC §101

Claim 14 stands rejected under 35 USC Section 101 as being directed to allegedly non-statutory subject matter in that the Examiner alleges that “[claim 14] raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art . . . which would result in a practical application producing a concrete, useful, and tangible result . . .”

First, the Examiner fails to clearly state just in what manner he finds Claim 14 deficient; rather, he makes the naked conclusionary statement that Claim 14 merely “raises a question” without identifying what that question is, the basis of the question or the inference which would give rise to the alleged conclusion that Claim 14 “is directed merely to an abstract idea that is not tied to a technological art . . . which would result in a practical application producing a concrete, useful, and tangible result . . .” Accordingly, should the Examiner fail to withdraw the rejection to claim 14 under 35 USC Section 101, he is respectfully requested to: (1) more fully state the basis of the allegation that it is “directed merely to an abstract idea that is not tied to a technological art . . . which would result in a practical application producing a concrete, useful, and tangible result”, (2) state the basis of any inferences which tie the allegation to the proposition, (3) state the question raised, and (4) state exactly why the basis and inference would lead one to answer “the question raised” that Claim 14 is “merely an abstract idea” and why Claim 14 does not “produc[e] a concrete, useful, and tangible result.”

Second, the Applicant notes that no such language quoted above (but used by the Examiner) appears in 35 USC Section 101. The Examiner is respectfully requested to provide citation so that the Applicant may more fully respond.

Third, it is respectfully pointed out to the Examiner that Claim 14 adds to the claim from which it depends (Claim 10) by providing a further tangible result in that data does not necessarily include code, as will be readily apparent to one of ordinary skill in the Personal Digital Assistant (PDA) art *after* reading the disclosure of the invention. Accordingly, the Examiner is respectfully requested to withdraw the rejection to claim 14 under 35 USC Section 101.

Rejections Under 35 USC §102

Claim 17 and claims that depend therefrom stand rejected under 35 USC §102 in view of *Patsiokas*. The Applicant respectfully traverses the rejection under 35 USC §102. The Examiner's reliance on extrinsic evidence (outside of *Patsiokas*' four corners) necessarily takes the examination out of 35 USC 102, which requires that the single reference alone must teach the Applicant's invention. Second, *Patsiokas* is unqualified as a reference under 35 USC §102 because *Patisokas* does not enable one to receive satellite radio transmissions on a PDA. Third, the Examiner failed to properly define the scope and meaning of each claim limitation so that the Applicant can determine if the Examiner properly understands each limitation of claim 17. Rather, as is demonstrated below, the *Patsiokas* reference is mischaracterized, and misused to expand the interpretation of its teachings beyond any reasonable reading. Thus, *Patsiokas* does not teach the invention as arranged as in the claims and should be withdrawn as a reference under 35 USC §102.

I. Requirement for Examiner to Rely on Single Reference

Claim 17 and claims that depend therefrom stand rejected under 35 USC §102 in view of *Patsiokas*. By implication, it is being asserted that *Patsiokas* teaches, within its four corners, each and every element of, in the detail and the manner of, the claims of the invention. On the

law of anticipation, Judge Learned Hand stated:

No doctrine of the patent law is better established than that a prior patent or other publication to be an anticipation must bear *within its four corners* adequate directions for the practice of the patent invalidated. *Dewey & Almy Chem. Co. v. Mimex Co.*, 124 F.2d 986, 989 (2d Cir. 1942).

Accordingly, the Examiner may rely on only a single reference, and the single reference must show each and every element as set forth (“arranged”) in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). The Examiner’s reliance on evidence outside the four corners of a single reference (explained in more detail below) indicates that the examiner should withdraw the rejections based on Rodgers, and such withdrawal is requested.

II. Requirement of Enablement to Qualify as a Reference

Further, the reference relied upon must be enabling. In *Paperless Accounting, Inc. v. Bay Area Rapid Transit Systems*, 804 F.2d 659, 665 (Fed Cir. 1986): “[A] §102[(b)] reference must sufficiently describe the claimed invention to have placed the public in possession of it . . . [E]ven if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling . . .” See also, *Akzo N.V. v. U.S.I.T.C.*, 808 F.2d 1471, 1479 (Fed. Cir. 1986) (“the prior art reference must be enabling. . .”). The reference must be enabling with respect to the claimed invention (as opposed to the underlying device or method taught in the reference). If the reference is inoperative with respect to the claimed invention, then the reference does not teach the invention and is not prior art. *In re Shepard*, 172 F.2d 560 (C.C.P.A. 1949).

Patsiokas teaches a standard satellite radio receiver, but does not teach, show, or suggest, for example: (1) “dispatching [a] satellite data element” (claim 17), (2) “receiving a tuning

command from a handheld computing device” (Claim 18) or “a handheld compatible bus interface” (claim 20). Nowhere does *Patsiokas* teach, show or suggest a handheld computing device. In fact, the device of *Patsiokas* is taught to be placed in an automobile—and an automobile can hardly be said to be a handheld computing device. *A non-enabling reference must not even be considered as a reference. In re Wilder*, 429 F.2d 447 (C.C.P.A. 1964). Accordingly, the Examiner is respectfully requested to withdraw the rejection to the Applicant’s invention under 35 USC §102 in view of *Patsiokas*.

III. Examination Deficiencies

The Examiner has failed to enter evidence and facts sufficient to establish a prima face case of anticipation. To establish a Prima Facie basis for anticipation, the Examiner bears the burden to show the factual basis of the anticipation rejection. *In re Warner*, 379 F.2d 1011, 389 U.S. 1057 (1968). Such basis must be both factually sufficient, and reasonable.

In addition, to establish a prima face case of anticipation, the Examiner further bears the burden to first show a correct interpretation, including the *scope and meaning*, of *each* contested limitation. *Gechter v. Davidson*, 116 F.3d 1454 (Fed. Cir. 1997). This is required, in part, so that the Applicant can ascertain whether or not the Examiner understands the invention, and so that the Applicant can frame a response. 37 CFR 1.106(b). Of course, the interpretation must rely on teachings found within the four corners of the reference. *Dewey & Almy Chem. Co. v. Mimex Co.*, 124 F.2d 986, 989 (2d Cir. 1942). Here, the Examiner seems to say that *every* limitation is contested by often referencing nothing more than drawings and an abstract (for example, Claim 18), which are ambiguous, at best. If the Examiner maintains the present rejection, the Examiner is requested to (should the Examiner fail to withdraw the rejection to claim 17 and those that depend therefrom), with respect to each element: (1) more fully state the basis of the allegation that each particular element is taught by *Patsiokas*, (2) state the basis of any inferences which tie the allegation to the proposition of anticipation, and (3) state exactly why the basis and inference would lead one to conclude that each element is anticipated by

Patsiokas beyond mere reference to drawings. Referencing drawings and nothing more reduces the sacred art of patent examination to little more than an ink-blot test.

Rejections Under 35 USC §103

The Examiner rejects independent claims 1, 10, and 15 and those that depend therefrom under 35 USC 103 as being obvious under *Himmel* in view of *Takeuchi*. For the following reasons, the rejections under 35 USC 103 do not raise a prima face case of obviousness, are improperly applied, and should be withdrawn.

Misuse of Cited References

Himmel Reference

The Examiner states that Himmel discloses an apparatus comprising a satellite receiver (claimed to be reference number 172) adapted to receive satellite signals (allegedly paragraph 49) with a decoder coupled to the satellite receiver for receiving a satellite data element comprising an audio signal element (allegedly paragraph 43), and a handheld compatible bus interface (no support). The Examiner then admits that Himmel fails to disclose the decoder adapted to convert a satellite signal into a satellite data-element.

Response:

The misrepresentations made by the Examiner are breathtaking, *to wit*:

1. Himmel extends an internal system bus externally via a wireless transceiver for communicating with peripheral devices, such as a printer.
2. Nowhere in Himmel is a satellite reception even mentioned in passing (though the Examiner states paragraphs 43 and 49 do, there is simply NO support for this proposition).
3. Reference number 172 does NOT refer to a satellite receiver as represented by the Examiner; rather it is a simple wireless receiver adapted to receive a local network protocol, presumably such as is used in an 802.11 network (see reference to a LAN in paragraph 43).

Accordingly, Himmel cannot be said to teach show or suggest:

1. a satellite receiver (no support);
2. no satellite receiver can be said to be adapted to receive satellite signals (allegedly paragraph 49)
3. The decoder of figure 7 is a bus-interface decoder, NOT a satellite signal decoder.
4. The Examiner then uses an incorrectly identified decoder to attach to an incorrectly identified satellite receiver.
5. No satellite data element is even mentioned anywhere in Himmel.
6. No handheld compatible bus interface is identified.
7. The Examiner admits Himmel fails to disclose the claimed decoder.

Indeed, the Examiner fails to demonstrate how Himmel teaches even one element of any of the independent claims of the invention as claimed by the applicant in claims 1, 10, and 15 and thus any claim rejection relying on Himmel fails to make even a prima face case of obviousness under 35 USC 103. All rejections to any claim under 35 USC 103 which incorporates Himmel should be withdrawn.

Takeuchi Reference

The Examiner states that Takeuchi teaches a portable telephone wherein an analog signal being inputted and having an analog to digital converter therein.

Response:

That the Examiner cites an *analog* cellular telephone to the teachings of this invention are indicative of just how revolutionary the Applicant's invention truly is. Takeuchi is a poorly translated Japanese application that "teaches" applying a direction keys to a portable telephone. The proposition that Takeuchi's A/D converter referenced in paragraph 77 (for use as a "dubbing" function – see Paragraph 77) in no way teaches, shows or suggests converting a satellite data element into an audio signal element as claimed by the Applicant.

All rejections to any claim under 35 USC 103 which incorporates Takeuchi should be withdrawn.

1. There Must Be a Basis in the Art for Combining or Modifying References

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffiore Hospital*, 732 F.2d 1572, 221 USPQ 929,933 (Fed. Cir. 1984). The fact that neither Himmel nor Takeuchi teach, show, suggest, or reference satellite radio transmission is itself proof that there is no motivation to combine the references.

Motivation Legal Background

Recently, Judge Newman in her opinion in *In re Lee*, 277 F3d. 1338, 1343, 61 USPQ2d 1430, (Fed Cir. 2002) repeats this fundamental principle:

When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.

Clearly, more than “common sense” is needed to support any claim of obviousness. Accordingly, the CCPA has expressly held that there must be some logical reason apparent from the evidence of record that would justify a combination or modification of references. *In re Regel*, 188USPQ 132 (CCPA 1975). In determining whether one of ordinary skill in the art would find it obvious to modify or combine references, the teachings of the reference taken with the knowledge that a worker in the art already possesses constitute the scope and content of the prior art that is referred to in the *Graham* decision. Thus, the question raised under § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art. Accordingly, even if all elements of a claim are disclosed in various prior art references, the claimed invention taken as a whole cannot be said to be obvious

without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention. *In re Regel, supra*. Where no reasonable intrinsic or extrinsic justification exists for the proposed combination or modification, *prima facie* obviousness will not have been established.

The Federal Circuit has also repeatedly warned against using the applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. *See, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d. 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

The black letter law statements by Judge Linn in *In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313 (Fed. Cir. 2000) address this subject, *viz*:

a) Hindsight Syndrome

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect taught is used against the teacher." (*Id.* At 1369, 55 USPQ2d at 1316) (citations omitted).

b) Need for Motivation

Most if not all inventions arise from a combination of old elements. ... Thus, every element of a claimed invention may often be found in the prior art. *See id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *See id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (*Id.* at 1369, 55 USPQ2d at 1316) (citations omitted).

(c) Particular Findings Required

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. ... The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. ... Whether the Board relies on an express or an implicit showing, it must provide particular findings related thereto. Broad conclusory statements standing alone are not “evidence.” (*Id.* at 1370, 55 USPQ2d 1317) (citations omitted).

Motivation Analysis

The Examiner does not provide a single motivation for either combining Himmel with Takeuchi, or for altering these references to achieve the invention as defined in claims 1, 10, or 15. The Applicant is thus left to guess the nature of the alterations and to guess the motivations for alterations. This is clearly contrary to above cited law that requires the Examiner to specifically define elements, specifically identify alterations and the motivations for making the alterations, and to specifically identify motivation for making combinations. However, there are no findings that would justify a motivation to modify Himmel to achieve any of the teachings of invention, much less the teachings in claims 1, 10 or 15. Nor does the Examiner identify the source for a motivation to combine Himmel with Takeuchi to achieve the teachings of claims 1, 10 or 15. Accordingly, withdrawal of the rejections to claims 1, 10, and 15 based on Himmel in view of Takeuchi under 35 USC 103 is respectfully requested.

2. References Are Not Properly Combinable or Modifiable if the Reference(s) Teach Away From the Modification or Combination

If the prior art teaches away from a combination, then a §103 rejection does not rise to the dignity of *prima facie* obviousness. It is unnecessary to submit rebuttal evidence when the

reference used to reject the claim teaches away from the limitation, or is silent on it and other art teaches away. In short, teaching away is the antithesis of the art suggesting that the person of ordinary skill go into the claimed direction. *In re Fine*, 873 F.2d 1071, 5 USPQ 2d 1596 (Fed. Cir. 1988). Essentially, teaching away from the art is a per se demonstration of lack of *prima facie* obviousness. The fact that neither Himmel nor Takeuchi teach, show, suggest, or reference satellite radio transmission is itself proof that these reference even if combined do not teach the invention as claimed by the applicant.

Teaching Away Analysis

Neither Himmel nor Takeuchi:

1. teach, show or suggest satellite reception;
2. teach, show or suggest satellite radio reception;
3. teach, show or suggest any element of a device adapted to receive a satellite signal.

Himmel and Takeuchi:

1. are assigned different art identifiers by the Patent Office (class 709/710 vs. class 345);
2. are completely incompatible with each other absent untaught modifications;
3. receive no benefit by their combination, even if it were made;
4. do not teach show or suggest even one element of claims 1, 10 or 15 as claimed by the Applicant.

Accordingly, the rejections under 35 USC 103 to claims 1, 10, and 15 and those that depend therefrom based on Himmel in view Takeuchi or any reference should be withdrawn and withdrawal of the same is requested so that claims 1, 10, and 15 and those that depend therefrom may be noticed for allowance.

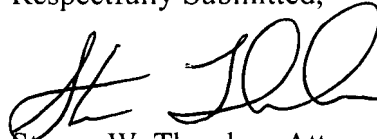
In the Event Arguments are Believed Insufficient

Thus, it is believed that the pending claims are allowable, and allowance of said claims is respectfully requested. Other references made of record but not relied upon in the Office Action

are considered no more relevant to the invention than the reference relied upon by the Examiner.

If the Examiner has other matters which remain, the Examiner is encouraged to contact the under signed attorney to resolve these matters by Examiners Amendment where possible.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'St. J. Q.' or similar, written in a cursive style.

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